



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,010	01/02/2002	Pierre Legrain	EGYPSA 3.0-002	6606
530	7590	03/24/2004	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				LAMBERTSON, DAVID A
ART UNIT		PAPER NUMBER		
		1636		

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/038,010	LEGRAIN ET AL.
	Examiner David A. Lambertson	Art Unit 1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 October 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-7 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 3, drawn to a particular complex of interacting proteins, and the host cells comprising the interacting proteins, classified in class 530, subclass 350.
- II. Claim 2, drawn to a particular complex of interacting polynucleotides, classified in class 536, subclass 23.1.
- III. Claim 4, drawn to a method of identifying a compound that modulates cell growth, classified in class 435, subclass 6.
- IV. Claims 5 and 6, drawn to a (pharmaceutical) compound that modulates cell growth, classified in class 514, subclass 1.
- V. Claim 7, drawn to a record of data set forth in Tables 1 and 2, classified in class 702, subclass 20.

Upon the election of Group I or II, Applicant must select either a particular protein-protein interaction or nucleotide-nucleotide interaction (e.g., Human Skp1 and KIAA0483, if the first interaction is elected), as each of the individual interactions are considered to be distinct inventions. This is not a species election because each of the individual complexes comprises different binding partners, where the collective members of the complexes have distinct biochemical structures from the other complexes. It is noted that for the sake of brevity (there are over 40 pages of interactions set forth in the specification), each individual interaction is not

being described as an individual group, although they clearly are. If a particular interaction is not elected, the response will be considered non-responsive.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions that are not disclosed as capable of being used together. Specifically, the invention of Group I relates to a complex of proteins, where each protein has a specific biochemical function associated with the particular amino acid structures. These specific biochemical functions cannot be performed by the corresponding polynucleotides because the polynucleotides have a different function associated with their particular structures, that being the encoding of a protein. Because the inventions have distinct functions and related structures, the inventions are considered patentably distinct.

Inventions I-II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects and are not disclosed as capable of being used together. Specifically, the inventions of Groups I and II have specific biochemical functions associated with the particular structures of the molecules, and these lead to the effect of a specific activity (associated with a protein) or the ability to encode a particular protein (associated with the nucleic acid). The effect of Group III is the identification of a modulating compound, which

does not result in the production of a polypeptide with a specific activity. Thus, the inventions have different results, and are patentably distinct because of this difference in the effects of each invention.

Inventions I-II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. Specifically, the inventions of Groups I and II have specific biochemical functions associated with the particular structures of the molecules, and these lead to the effect of a specific activity (associated with a protein) or the ability to encode a particular protein (associated with the nucleic acid). The effect of Group IV is the ability to inhibit the growth of a cell, which is a different function than the production of a polypeptide with a distinct biochemical function. Furthermore, the compound has a structure that is not necessarily associated with either an amino acid sequence or a polynucleotide sequence, and this structure is directly related to the function of the compound. As a result of the differences in function, the inventions are considered patentably distinct.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and effects and are not disclosed as capable of being used together. Specifically, the invention of Group III is directed to the identification of a compound, whereas the invention of Group IV is directed to a compound that has the ability to modulate

cellular growth. Thus, the inventions have different functions, and have different results in that one results in the identification of a compound whereas the other results in the modulation of cell growth. Because the inventions have distinct functions and effects, the inventions are determined to be patentably distinct.

Inventions I-IV and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. Specifically, Groups I-IV each has a distinct biochemical function, which is absent from the record of Group V which is simply a collection of data that has no biochemical function. Since the inventions have different functions, they are properly restricted as distinct inventions

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, especially in instances where the classifications are the same, the non-patent literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

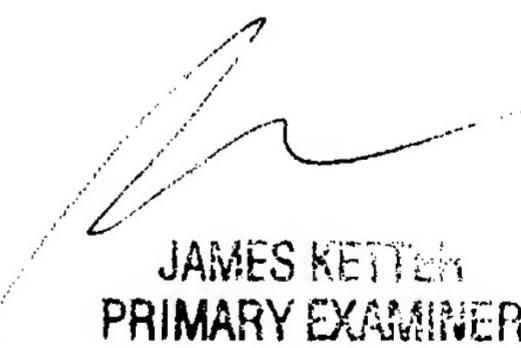
Art Unit: 1636

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.
AU 1636



JAMES KETTER
PRIMARY EXAMINER